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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,322	12/29/2000	Rob Sullivan	10559/197001/P8369	9163
20985	7590	01/26/2006	EXAMINER	
FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			SMITH, SHEILA B	
			ART UNIT	PAPER NUMBER
			2681	
DATE MAILED: 01/26/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/751,322	SULLIVAN ET AL.	
	Examiner	Art Unit	
	Sheila B. Smith	2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-22 is/are allowed.
- 6) ☐ Claim(s) 1-17 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/12/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-17, 23-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Messner (U. S. Patent Number 6,370,514).

Regarding claim 1, Messner discloses essentially all the claimed invention as set fourth in the instant application, further Messner discloses a method for marketing and redeeming vouchers for use in online purchases. In addition Messner discloses a method comprising: receiving an electronic order for at least one good or service (which reads on purchaser selects gift certificate option) from a first party (which reads on purchaser) ; receiving information about the first party (which reads on “It is preferable that the purchaser 90 supply his name and at least one "address" (preferably, the purchaser will supply both a mailing and an e-mail address) as a part of the purchase” as disclosed in column 8 lines 47-50); transmitting information which will be necessary to process the order (which reads on purchaser selecting delivery option) to a second party (which reads on “over the phone, at a brick and mortar store, at a virtual mall, or a merchant web site on-line, or at the web site of the operator of the certificate system” as disclosed in column 3 lines 4-7); transmitting less information about the

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first party to the second party than was received (which reads on “Once the purchase form is completed and payment is approved, the voucher server 54, and associated business processes then attempt to deliver the gift certificate 100” as disclosed in column 9 lines 51-53); and transmitting a voucher to the second party (which reads on “Delivery of the voucher, according to the method selected by the purchaser, is then attempted” as disclosed in column 3 lines 15-17) and at the second party (which reads on “over the phone, at a brick and mortar store, at a virtual mall, or a merchant web site on-line, or at the web site of the operator of the certificate system” as disclosed in column 3 lines 4-7), filling the order for the good or service (which reads on goods/services shipped as exhibited in figure 2B).

Regarding claims 2,8 Additionally Messner discloses transmitting no information about the first party to the second party (which reads on Once the purchase form is completed and payment is approved, the voucher server 54, and associated business processes then attempt to deliver the gift certificate 100” as disclosed in column 9 lines 51-53).

Regarding claims 3, 9 Additionally Messner discloses 3. The method of claim 1, further comprising transmitting selected information about the first party to the second party, wherein transmission of the selected information is authorized by the first party (which reads on column 9 lines 51-53).

Regarding claims 4, 10 Additionally Messner discloses comprising retrieving information from a database concerning the first party, and selecting information about the first

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party for transmission to the second party based on the retrieved information (which reads on column 9 lines 51-53).

Regarding claims 5,11 Additionally Messner discloses retrieving records from a database concerning the first party comprises retrieving directives describing the information to be withheld from the second party (which reads on column 9 lines 51-53).

Regarding claims 6, 12 Additionally Messner discloses receiving information about the first party comprises receiving information about the first party from a subscriber identity module (which reads on column 8 lines 47-50).

Regarding claims 7, Messner discloses essentially all the claimed invention as set forth in the instant application, in addition Messner discloses a article comprising a computer-readable medium which stores computer-executable instructions for receiving and transmitting information (which reads on "The term "Internet" will be used throughout this document. As used herein, "Internet" means a network of machines accessible to/by multiple users, the machines having the capability, using a common communication protocol, of communicating pursuant to programming commands or information input by users" as disclosed in column 1 lines 61-65), the instructions causing a machine to, receiving an electronic order from a first party (which reads on "purchasing or receiving vouchers, such as: over the phone, at a brick and mortar store, at a virtual mall, or a merchant web site on-line, or at the web site of the operator of the certificate system" as disclosed in column 3 lines 4-7); receiving information about the first party (which reads on "It is preferable that the purchaser 90 supply his name and at least

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one "address" (preferably, the purchaser will supply both a mailing and an e-mail address) as a part of the purchase" as disclosed in column 8 lines 47-50); a transmitting information that will be necessary to process (which reads on purchaser selecting delivery option) to a second party (which reads on "over the phone, at a brick and mortar store, at a virtual mall, or a merchant web site on-line, or at the web site of the operator of the certificate system" as disclosed in column 3 lines 4-7); transmitting less information about the first party to the second party than was received (which reads on "Once the purchase form is completed and payment is approved, the voucher server 54, and associated business processes then attempt to deliver the gift certificate 100" as disclosed in column 9 lines 51-53); and transmitting a voucher to the second party (which reads on "Delivery of the voucher, according to the method selected by the purchaser, is then attempted" as disclosed in column 3 lines 15-17) and at the second party (which reads on "over the phone, at a brick and mortar store, at a virtual mall, or a merchant web site on-line, or at the web site of the operator of the certificate system" as disclosed in column 3 lines 4-7), filling the order for the good or service (which reads on goods/services shipped as exhibited in figure 2B).

Regarding claims 13-17, Messner discloses essentially all the claimed invention as set forth in the instant application, in addition Messner discloses a system comprising: a processor (which reads on a voucher server) and a database (which reads on page column 12 lines 2-3), wherein the processor is configured to receive information about a first party (which reads on page column 7 lines 36-43), wherein the processor is configured to receive an electronic transactional order from the first party, wherein the processor transmits (which reads

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on purchaser selecting delivery option) to a second party (which reads on “over the phone, at a brick and mortar store, at a virtual mall, or a merchant web site on-line, or at the web site of the operator of the certificate system” as disclosed in column 3 lines 4-7), and wherein the database includes information about the first party and directives describing the information about the first party to be transmitted to the second party (which reads on column 7 lines 36-43).

Regarding claims 23-25, Messner discloses essentially all the claimed invention as set forth in the instant application, in addition Messner discloses a method comprising: placing an electronic order with a second party on behalf of a first party (which reads on column 12 lines 2-3; and providing information about the first party to the second party (which reads on adequate funds available); wherein the amount of information provided is a function of consideration from the second party (which reads on confirmation packet transmitted to merchant/mall as exhibited in figure 2A).

Regarding claims 26 - 28, Messner discloses essentially all the claimed invention as set forth in the instant application, in addition Messner an article comprising a computer-readable medium which stores computer-executable instructions for receiving and transmitting information (which reads on The term "Internet" will be used throughout this document. As used herein, "Internet" means a network of machines accessible to/by multiple users, the machines having the capability, using a common communication protocol, of communicating pursuant to programming commands or information input by users” as disclosed in column 1 lines 61-65), the instructions causing a machine to placing an electronic order with a second party on behalf of a first party (which reads on column 12 lines 2-3; and providing information about the first

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party to the second party (which reads on adequate funds available); wherein the amount of information provided is a function of consideration from the second party (which reads on confirmation packet transmitted to merchant/mall as exhibited in figure 2A).

Allowable Subject Matter

1. Claims 18-22 are allowed.

Response to Arguments

2. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

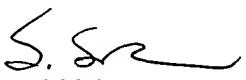
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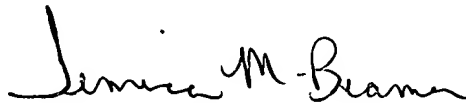
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheila B. Smith whose telephone number is (571)272-7847. The examiner can normally be reached on Monday-Thursday 6:00 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Smith 
January 23, 2006


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